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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,663	06/20/2003	Antonio Gomez	200309525-1	5679

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EXAMINER

LIANG, LEONARD S

ART UNIT PAPER NUMBER

2853

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/600,663

Applicant(s)

GOMEZ ET AL.

Examiner

Leonard S. Liang

Art Unit

2853

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
MANISH S. SHAH  
PRIMARY EXAMINER

02/16/06

LSL

Continuation of 3. NOTE: The amendments to the claims require further consideration and a new search.

Continuation of 11. does NOT place the application in condition for allowance because: The arguments are not persuasive. The examiner has carefully considered the applicant's arguments and agrees with the applicant that the history of the record is confusing. As such, the examiner will attempt to clarify the record and in so doing, will hopefully clarify why it is believed that the final rejection filed on 12/01/05 is proper. On 12/09/04, a non-final rejection was filed. This rejection objected to claims 2, 8, 9, and 16 as being allowable. On 05/26/05, the examiner issued a new non-final rejection which rejected claims 2 and 16. Because the examiner performed a new rejection on previously objected claims, this action was made non-final. In response, on 08/12/05, the applicant cancelled claim 16 and put the limitations of the no-longer-objected-to claim 2 into claim 1. Furthermore, the applicant also added some language to this new claim 1, such as the word "only." Though claims 1-2 were rejected over Taylor et al (US Pat 5617124) in the 05/26/05 non-final rejection, the examiner rejected this new claim1/claim 2 amalgam over Therien (US Pat 6213583) in the 12/01/05 final rejection. The applicant is currently arguing that the final rejection filed on 12/01/05 is improper because the only amendment made was the moving of the limitations of dependent claim 2 into independent claim 1. The examiner has a few comments in response. First, the applicant's arguments seem to imply that the examiner rejected the moving of an objected claim into independent form and then made that rejection final. This is not the case. Though claim 2 was originally objected to on 12/09/04, a new non-final rejection was already given rejecting it on 05/26/05. Therefore, this is not a case of moving an objected claim into independent form; rather it is a case of moving a rejected claim into independent form. Second, although the applicant will argue that the word "only" is only "clarifying language," the truth is that the inclusion of the word drastically changed the scope of the claim. In a printing system with multiple rollers and multiple printheads, one of ordinary skill in the art will appreciate the difference between saying that one of the rollers receives ink from one of the printheads and saying that the roller "only" receives ink from that printhead. The latter case excludes any other printheads from ejecting ink onto that roller; the former case does not. For these reasons, the examiner considers the finality of the rejection made on 12/01/05 to be proper. To further support this contention, the applicant will notice that the examiner used different pieces of art to reject claims 1 and 2 in the 05/26/05 rejection and the amalgated claim 1/2 in the 12/01/05 rejection. If the amended claim 1 in the 12/01/05 rejection was nothing more than the moving of the claim 2 limitations into claim 1 as the applicants claim, why then did the examiner use a new piece of art to reject? The examiner gave weight to the word "only" by conducting a new search and giving further consideration to the case. That's how the new piece of art was found. The examiner recognizes that the new art also overturned the previously objected to claims 8-9. However, the change of the scope of claim 1 was what necessitated the new search. Therefore, finality is considered proper. Currently, the applicant has proposed amendments by incorporating limitations from claims 13 and 16 as originally filed. However, as mentioned above, claim 16 was cancelled in the last action. Therefore, any attempt to re-introduce concepts from the originally filed claim 16 into the claims is considered new matter which change the scope of the claims. That is why this advisory action is being issued and the amendments will not be entered. The examiner hopes that this has helped to clarify the record .

  
2/16/06  
**MANISH S. SHAH**  
**PRIMARY EXAMINER**